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09/609,232	06/30/2000	Kia Silverbrook	NPB003US	2830
24011	7590	06/15/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/609,232

Applicant(s)

SILVERBROOK ET AL.

Examiner

Khanh H. Le

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ME

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9 and 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **Detailed Action**

1. This Office Action is in response to the Amendment entered 3/25/04. Claims 1-36 were pending. Claims 6, 10-11 are cancelled. Claims 1-5, 8, 13, 17, 21, 24, 36 are amended. Claims 1-5, 7-9, 12-36 are pending. Claims 1 and 36 are independent. All amendments to the claims and the specifications have been entered.

### ***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. As to canceled claims 1, 6, 10 previous rejections are withdrawn as moot. Previous rejections as to claims 5, 13, 17, 18, 21 and 24 are withdrawn as appropriate correction has been made.

4. **Claims 5 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 5 (new rejection): it is unclear why claim 5, dependent on claim 4 which is dependent on claim 3, would contain "an proportional payments corresponding to the number of requests of first information that is printed" which is interpreted to be the same as "...also responsive to the number of first media printed" of claim 3. For art application purposes the two phrases are interpreted to be the same. Appropriate correction or clarification of the scope to the claim is required.

Claims 21 (new rejection): "**the** number of requests of the fifth information" lacks antecedent basis. A step of requesting the fifth information is missing. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1-5, 7-9, 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Intelligent Paper” by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, herein “Intelligent Paper”.**

As to claims 1 and 3:

Intelligent Paper discloses

A system for providing printed information to a user that is obtained from a first server of a first party, the system including:

a user printer module being provided by a second party for interfacing the user with the first server, the module being responsive to the user requesting first information from the first server for generating a first printed media that displays the first information (see Intelligent Paper p. 392-393:interpreted as the Intelligent Paper is printed by the second party for sale to consumers. All other claimed components are implicitly present in INTELLIGENT PAPER).

identifier of a third party for providing the first printed media with an identifier such that designation of the identifier by the user results in the module communicating second information to the first server or to a second server of a fourth party (Intelligent Paper p. 397, last paragraph, third party is the “router”)

account means for providing payments to the third party and for receiving payments from the second party (Intelligent Paper p. 397, last paragraph,” the intelligent paper pages can be sold at a price that covers the cost of storing the page-id –URL relation”, i.e. the second party

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bears the cost of the third party (implicitly pays the third party )and passes on the cost to the consumer. All other claimed components are implicitly present in INTELLIGENT PAPER).

INTELLIGENT PAPER also implicitly discloses many user modules as claimed in claim 3.

INTELLIGENT PAPER does not specifically disclose calculating payments to the third party, which are proportional to the number of first media printed by the module(s)

(Note: the number of requests of the first information (claim 1) is interpreted as the same as the number of first media printed (claim 3) because implicit in the printing of the obtained content is the prior request for the content as claimed in claim 1).

However, Official Notice was taken that it is well-known that usable printed papers are sold by the sheet (LAST OFFICE ACTION at page 5, 2<sup>nd</sup> para.), was unchallenged and therefore taken as admitted.

Thus it would have been obvious to one skilled in the art at the time of the invention to add this conventional cost feature to the Intelligent Paper scheme to compensate the on-line publishing party for use of the content on-line (by request of the content only, as claimed in claim 1) or by printing as well (as claimed in claim 3).

Claim 2 (dependent on claim 1) :  
Official Notice is taken that monitoring of printed sheets by a printing facility for accounting purposes (“calculation means which is responsive to the identifier means for determining the payments”) is well-known and thus obvious to add to INTELLIGENT PAPER to allow accounting based on number of prints as discussed above.

Claim 4 (dependent on claim 3) states:

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“wherein the calculation is also responsive to the number of occurrences of second information being sent to the first server or the second server for determining the payment from the first party (or the fourth party) respectively wherein the first and the fourth parties are respective on-line publishers “.

Intelligent Paper at p. 399-401 discloses linking to on-line content providers for more information (interpreted as ads or content or commercial transactions information). Official Notice was taken that it is well-known parties referring potential consumers to commercial websites get rewarded by the websites owners (LAST OFFICE ACTION at page 4, next to last paragraph), was unchallenged and therefore taken as admitted. The Intelligent Paper page id-URL router is interpreted as the third party playing the role of such referring party to the first or fourth parties (advertisers, commercial websites). Thus it would have been obvious to one skilled in the art at the time of the invention to add this well-known referral commissions feature (paying the third party for the referral by the first or fourth parties) to INTELLIGENT PAPER to allow e-commerce commissions sharing in the networked INTELLIGENT PAPER context as has been done in other e-commerce contexts.

Claim 5 (dependent on claim 4):

“.. proportional payments corresponding to the number of requests of first information that is printed”, is disclosed as shown in claims 1 and 3.

However, Intelligent Paper does not disclose “the payments they (the 1<sup>st</sup> or 4<sup>th</sup> parties) make are a combination of a fixed payment for a predetermined period and proportional payments corresponding to the number of requests of first information that is printed”.

However Official Notice was taken that it is well-known payment as fixed amounts per fixed periods are common commercial service contract terms used for simplicity thus it would have been obvious to one skilled in the art at the time of the invention to add such feature to the scheme of Intelligent Paper in order to achieve the above mentioned advantage (LAST OFFICE

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ACTION at page 4, last paragraph). The Official Notice was unchallenged and therefore taken as admitted.

Thus, the combination of a fixed periodical fee and proportional fees based on a number of printed media also would have been apparent to one skilled in the art in order to assure the on-line publisher a minimum compensation. ( Note: Herein, the first and 3<sup>rd</sup> parties are interpreted as one party, as disclosed in the Specifications at page 72, line 6-8).

Further, it is obvious to make integral what was separate when no technical hurdles are overcome. See *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958). Thus adding two well-known schemes of compensation is obvious.

Further this particular claimed compensation scheme is a matter of agreement between the parties and thus is obvious if the parties so desire.

As to claim 7 (dependent on claim 1): Intelligent Paper at pages 400-401 discloses linked commercial transactions. It is thus interpreted that a vendor (4<sup>th</sup> party) , and orders for goods (2<sup>nd</sup> information) are involved in INTELLIGENT PAPER.

As to claim 8 (dependent on claim 7): Official Notice is taken that payment to the referring party based on the value and /or quantity of the goods/services ordered is well-known thus one skilled in the art at the time of the invention would have known to add such to INTELLIGENT PAPER to carry out conventional referral schemes in the INTELLIGENT PAPER context.

As to claim 9 (dependent on claim 7): Official Notice is taken that e-commerce referral schemes involving many on-line vendors connected to a network are known. Further as in claim 8, Official Notice is taken that payment to the referring party based on the value and /or quantity of the goods/services ordered is well-known thus one skilled in the art at the time of the

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invention would have known to add such known commission scheme , as applied to each vendor, to INTELLIGENT PAPER to carry out conventional referral schemes in the INTELLIGENT PAPER context of many connected vendors.

Claims 12-14:

The claimed types of payments/accounts are ordinary and well-known types and thus it would have been obvious to one skilled in the art at the time of the invention to add to Intelligent Paper to facilitate accounting among parties.

Claims 15-16:

Intelligent Paper discloses at page 404, 2<sup>nd</sup> full paragraph that a user peripheral used to receive the linked information after pointing on the intelligent paper is a printer (module) . Thus INTELLIGENT PAPER implicitly discloses a second printed medium can be obtained, via this printer, displaying third information, obtained from clicking on a first identifier on the first printed medium. INTELLIGENT PAPER further implies that the 3<sup>rd</sup> information is obtained from other parties such as a “1<sup>st</sup> party” or “4<sup>th</sup> party”.

Claim 17 (dependent on claim 16):

Intelligent Paper discloses at page 404, 2<sup>nd</sup> full paragraph that a user peripheral used to receive the linked information after pointing on the intelligent paper is a printer. Further, **INTELLIGENT PAPER** implicitly discloses a printer printing intelligent paper. Thus one skilled in the art at the time of the invention would have known to add a printer printing intelligent paper to the **INTELLIGENT PAPER** scheme to further provide more information, in response to a request to a first or 4<sup>th</sup> party, because an **INTELLIGENT PAPER** printer obviously can be used to provide more information as requested just as any other printer. Thus a second intelligent paper (the second printed media) can be obtained, to further provide more information in response to a request (4<sup>th</sup> information) to a first or 4<sup>th</sup> party.



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The second intelligent paper thus generated contains tags thereon ( second identifiers). INTELLIGENT PAPER further discloses clicking on them (sending 4<sup>th</sup> information) would generate more information as claimed.

Thus it would have been obvious to one skilled in the art at the time of the invention to add such printed paper with interactive tags to the Intelligent Paper scheme in order to provide information in an interactive intelligent paper format as disclosed by Intelligent Paper.

Claim 18 (dependent on claim 17):

As stated above, payment per click-through is known thus one skilled in the art at the time of the invention would have known to calculate referrals fees based on the number of 4<sup>th</sup> information communicated (i.e. implicitly based on the number of click-throughs on the second identifier which communicate 4<sup>th</sup> information) and to add such feature to the INTELLIGENT PAPER context to extend its e-commerce /referral network and to provide for appropriate referral fees as has been well-known in other e-commerce contexts.

Claims 19, 22-23: involve ads or information about other ads or content (fifth information) on the first printed media. **INTELLIGENT PAPER** implicitly discloses all such ads or content when mentioning linked e-transactions thus, **INTELLIGENT PAPER** discloses claims 19,22, 23.

Claim 20(dependent on claim 19)

Further, Official Notice was taken that it is known advertisers (fifth party) subsidizes the cost of usable papers (i.e. publications) in the last Office Action at page 5 , 5<sup>th</sup> full paragraph. The Official Notice was not challenged and thus taken as admitted.

Intelligent Paper also discloses, as stated above that the 2<sup>nd</sup> party (the publication printing party) pays the third/first party (the content owner and also content storage party) for the number of papers printed and passes on the cost to the user.

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( As stated above, herein, the first and 3<sup>rd</sup> parties are interpreted as one party, as disclosed in the Specifications at page 72, line 6-8).

As the advertiser (fifth party) subsidizes the printed media, as discussed above, it would be obvious that the 5<sup>th</sup> party pays into the account of the third party as claimed in claim 20.

Further, as the second party (the printing or printer owning party) pays the 3<sup>rd</sup> party based on the number of prints, if the 5<sup>th</sup> party subsidizes the 2<sup>nd</sup> party, as discussed above, it would have been obvious the 5<sup>th</sup> party also pays the 3<sup>rd</sup> party based on the number of prints, as claimed.

Claim 21 (dependent on claim 20)

The number of requests of the fifth information is interpreted as the same as the number of requests for the first information since both are interpreted as being on the same printed medium. Thus claim 21 is rejected on the same basis as claims 1 and 3.

#### **Claims 24-29**

Claim 24(dependent on claim 15):

Intelligent Paper at least at pages 392 discloses page id-URL mapping (mapping of identifiers . Thus it is implicit in INTELLIGENT PAPER that page data indicative of printed media, be it first or second or both would be stored in the Intelligent Paper system.

Claims 25-29 (dependent on claim 24):

Intelligent Paper at least at pages 392 discloses page id-URL mapping (mapping of identifiers and respective functions with one of the functions being placing order for goods/services). Per action of the Intelligent Paper user pointing and clicking on a tag to effect ordering of goods, Intelligent Paper implicitly discloses claims 25-28.

(Note: Intelligent Paper does not specifically disclose it is the printing module that determines and initiates the function after the user designates the identifier. However Intelligent

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Paper discloses the combination of a pointer and a peripheral such as a printer ( page 404 , 2<sup>nd</sup> full paragraph ) to initiate the function . Thus it is interpreted that the **INTELLIGENT PAPER** printer system is the printing module that initiates the function as the user points to a tag).

### **Claims 30-33**

As to claims 30-31 (dependent on claim 1): “ wherein the module stores in a cache mapping data indicative of at least the information printed on the media most recently generated and the identifier last designated”.

Official Notice was taken that caches, small fast memory holding recently accessed data, designed to speed up subsequent access to the same data are well-known to be used for a local copy of data accessible over a network on the assumption that the processor will probably need that data again soon. The Official Notice was unchallenged and therefore taken as admitted. Thus it would have been obvious to one skilled in the art at the time of the invention to add such cache to store the most recent data, such as, at least the information printed on the media most recently generated and the identifier last designated in order to achieve the well-known advantages of caches as discussed above.

Claim 32 (dependent on claim 31)

“wherein the media is a page and the cache is sufficiently large to allow the local storage of mapping data indicative of more than one page” .

Intelligent Paper discloses the media is a page. Further a cache is well-known to be large enough to be able to store mapping data indicative of more than one page thus it would have been obvious to one skilled in the art at the time of the invention to add such cache feature in the teachings of Intelligent Paper in order to allow rapid access if the user desires to access the identifiers on more than one page.

Claim 33 (dependent on claim 30).

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Intelligent Paper, discloses at p. 397, last paragraph, the third party (router) is a persistent storage provider of the mapping data for the printed media generated by the system.

Claims 34-35 (dependent on claim 1):

Intelligent Paper, at pages 396 (“technology”) discloses the identifier is printed on the respective printed media by one of the modules (the printing modules that later sell the paper to users) .

Claim 36 substantially parallels claim 1 and is rejected similarly.

### **Response to Arguments**

7. Applicants’ arguments have been carefully considered but deemed unpersuasive. As Applicants admit, Intelligent Paper discloses how page identifiers operate and how users use these identifiers to interact with digital pages. Applicants also admit Intelligent Paper discloses the storage provider is paid. (Applicants’ Response at page 9 and 10). Applicants dispute however that the precise relationship of how the payment is received and calculated is not disclosed. However the last Office Action has stated a number of Official Notices showing that payment schemes based on referrals by click-throughs for example among others are well-known. These Official Notices were not seasonably challenged and thus taken as admitted. MPEP 2144.03. Intelligent Paper in view of these well-known compensation schemes disclose the claimed payments schemes, contrary to argument.

### **Conclusion**

8. Prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

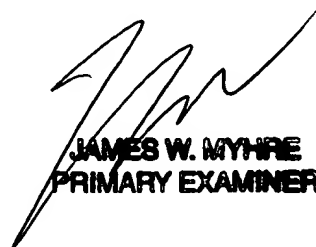
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

June 14, 2004

KHL

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**